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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,848	02/05/2004	Alan B. Kyker	42P5820C2	7181

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EXAMINER

DONAGHUE, LARRY D

ART UNIT	PAPER NUMBER
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2154

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/773,848

Applicant(s)

KYKER ET AL.

Examiner

Larry D. Donaghue

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-50 is/are pending in the application.
4a) Of the above claim(s) 42-50 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 22-41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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1. Claims 22-50 are presented for examination.
2. Applicant's election without transverse is noted, claims 42-50 have been withdrawn from further consideration.
3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 22-41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-7 of U.S. Patent No. 6,711,669. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 6 of patent 6,711,669 contain(s) every element of claim 22 of the instant application with different phrasing and as such anticipate(s) claims of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 22,23,25,27,29,30,36-37 and 40 rejected under 35 U.S.C. 102(b) as being anticipated by May (4,724,517).

May taught the invention as claimed including a method for compressing an immediate operand associated with a current instruction; storing the compressed operand in a selected one of a plurality of fixed length operand fields (fig. 5, col. 21, lines 45-49), wherein each of the operand fields is associated with one of a plurality of program instructions; wherein the plurality of program instructions includes the current instruction and an adjacent instruction (col. 22, line 55 – col. 23, line 7).

As to claim 23, May taught the adjacent instruction is a previous instruction; and storing the compressed operand further comprises storing the compressed operand in the operand field associated with the previous instruction (col. 22, line 55 – col. .

As to claim 25, May taught storing the compressed operand further comprises storing the compressed operand in the operand field associated with the current instruction (col. 22, line 55 – col. 23, line 7).

As to claim 27, May taught the adjacent instruction is a next instruction; and storing the compressed operand further comprises storing the compressed operand in the operand field associated with the next instruction (col. 22, line 55 – col. 23, line 7).

As to claim 29, May taught the compressing further comprises: compressing using sign extension (col. 22, line 55 – col. 23, line 7).

As to claim 30, May taught the plurality of program instructions includes the current instruction, a previous instruction and a next instruction (col. 22, line 55 – col. 23, line 7).

As to claim 36, May taught storing one portion of an immediate operand for a current instruction in a fixed-length operand field associated with the current instruction; and storing a remaining portion of the immediate operand for the current instruction in a fixed-length operand field (col. of an instruction adjacent to the current instruction; wherein the length of the immediate operand is Y bits and the length of the operand fields for the current instruction and the adjacent instruction is less than Y bits (col. 22, line 55 – col. 23, line 7).

As to claim 37, May taught the length of the operand fields for the current instruction and the adjacent instruction is Y/2 (col. 22, line 55 – col. 23, line 7). Noted May taught the operand can be up to 16 bits, therefore it can be less, if the operand is 8 bits, then both instructions contain Y/2 of the bits.

As to claim 38, May taught adjacent instruction is a previous instruction (col. 22, line 55 – col. 23, line 7).

As to claim 40, May taught the adjacent instruction is a next instruction (col. 22, line 55 – col. 23, line 7).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baum 5,303,358

Worrell 5,905,893

Kyker et al. 6,711,669

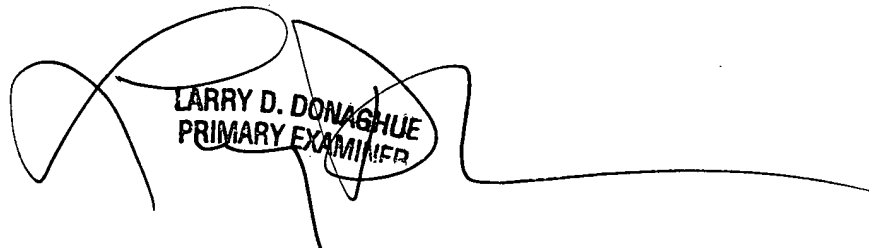
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Kyker et al.	6,338,132
Kyker et al.	7,114,057
May et al.	6,564,314
Itoh	6,253,314
Kubota et al.	6,167,505
Bauer et al.	6,049,862
Favor et al.	6,038,657
Nakakimura et al.	5,915,109
Purcell	5,625,784
Matsumoto et al.	5,745,722
Worrell	5,896,519

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D. Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LARRY D. DONAGHUE
PRIMARY EXAMINER